

REMARKS

Applicants have carefully reviewed this application in light of the Office Action mailed June 23, 2008. Claims 1, 3-20 and 22-28 are pending in this Application and Claims 1, 3-20 and 22-28 stand rejected under 35 U.S.C. § 103(a). Claims 2 and 21 were previously cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 1, 5-15, 18, 20, 24 and 27-28 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,996,450 issued to Edward J. Suttle (“*Suttle*”) in view of U.S. Patent No. 6,970,639 issued to John Mark McGrath (“*McGrath*”).

Claims 3-4, 22-23 and 25-26 stand rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over the combination of *Suttle* and *McGrath*, as applied to claim 1, in view of U.S. Patent No. 6,076,080 issued to William F. Morscheck (“*Morscheck*”).

Claims 16-17 and 19 stand rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over *Suttle*.

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on

ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The Applicants reiterate their arguments from their previous response that the cited references do not teach each and every element recited in the Claims. However, assuming *arguendo* that the cited references do teach all recited elements, the Examiner has not provided a proper rationale with the necessary factual findings for combining the cited references as is required by applicable law and the M.P.E.P. Under recently decided case law, even if each limitation is disclosed in a combination of references (which the Applicants do not concede with respect to the present case), a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

In the present case, the Examiner makes a conclusory statement that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Suttle* [as disclosed in *McGrath*] because it would advantageously allow to significantly reduce the amount of time reviewing the source content to get familiarized with the material to be edited, thereby improving the efficiency of the editing process” as a rationale to combine *Suttle* and *McGrath* to arrive at the claimed invention. The Applicants respectfully assert that such rationale is improper, as the Applicants’ Claims have absolutely nothing to do with content editing, an “editing process,” or getting familiarized with material to be edited. Given that the Examiner’s rationale is entirely divergent from the subject matter of the Claims, it seems unlikely that one of skill in the art could follow such rationale to arrive at the claimed subject matter, and thus would be motivated by the given rationale.

“The key to supporting any rejection under 35 U.S.C. [§] 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” M.P.E.P. § 2143 (emphasis added). The M.P.E.P. also states that “the analysis supporting a rejection under 35 U.S.C. [§] 103 should be *made explicit.* *Id.* (emphasis added). M.P.E.P. § 2143 also sets forth a host of exemplary rationales and Examiner may employ in maintaining a rejection, including particular findings of fact required to support each such rationale. In the present case, the Examiner has not made any such rationale explicit, has not supported the rejection using any rationale set forth in M.P.E.P. § 2143 or other suitable rationale, and has not made any factual findings to support any such rationale. For example, if the Examiner maintains rejections on a rationale the some teaching, suggestion or motivation in the prior art would have led one of ordinary skill in the art to modify and/or combine prior art references, the Examiner must make and articulate each of the following findings:

- a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of skill in the art, to modify the reference or to combine reference teachings;
- a finding that there was reasonable expectation of success; and
- whatever additional findings based on the factual inquiries under *Graham v. John Deere Co.*, 383 U.S. 1 (1966) as may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

M.P.E.P. § 2143(G).

The Examiner is respectfully reminded that any findings must be supported by documentary evidence in the record. 37 C.F.R. § 1.104(c)(2); M.P.E.P. § 2144.03(C). The Examiner is also respectfully reminded that if the Examiner relies on personal knowledge to support a finding of what is known in the art, such finding must be supported with an affidavit or declaration setting forth specific factual statements and explanation to support the finding. 37 C.F.R. § 1.104(d)(2); M.P.E.P. § 2144.03(C).

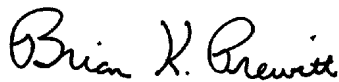
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of Claims 1, 3-20 and 22-28 as amended.

Applicants believe there are no fees due at this time; however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

Respectfully submitted,
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Date: September 23, 2008

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